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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,519	01/04/2001	Noboru Shibuya	450100-02938	4153

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EXAMINER	
HENNING, MATTHEW T	
ART UNIT	**PAPER NUMBER**
2131	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,519	SHIBUYA ET AL.	
	Examiner	Art Unit	
	Matthew T Henning	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to the communication filed on 11/26/2004.

DETAILED ACTION

1. Claims 1-2, and 4-9 have been examined and Claim 3 has been cancelled.

2. All objections and rejections not set forth below have been withdrawn.

Title

3. The title of the invention is acceptable.

Priority

4. The application has been filed under Title 35 U.S.C §119, claiming priority to Japanese application 2000000309, filed January 5, 2000.

5. The effective filing date for the subject matter defined in the pending claims in this application is January 5, 2000.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 07/17/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

7. The drawings filed on 01/04/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 1 and 9, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 and 9 recite the broad recitation "intermediary external equipment", and the claim also recites "such as a portable device" which is the narrower statement of the range/limitation. The ordinary person skilled in the art would be unable to determine whether the recitation "such as a portable device" was meant to limit "intermediary external device" to a portable device, or whether this was merely an example. As such, the ordinary person skilled in the art would be unable to determine the scope of the claims. Therefore, claims 1 and 9 are rejected for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

11. Claims 2, and 6-8 are rejected by virtue of their dependency to claim 1.

12. Claim 4 depends from claim 3, which has been cancelled. The examiner will assume that claim 4 should now depend from claim 1 since the limitations of claim 3 have been appended to claim 1. Claim 5 is rejected by virtue of its dependence to claim 4.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

14. Claims 1-2, and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi et al. (U.S. Patent Number 6,047,103) hereinafter referred to as Yamauchi.

15. Claim 1 recites a general-purpose computer (See Yamauchi Fig. 5 Element 49) having a central processing unit for executing predetermined processing as instructed by a program stored in an internal storage means in said general-purpose computer (See Yamauchi Fig. 5 Element 49C), said general purpose computer comprising: a loading means, which is integrally arranged on a case of said general-purpose computer (it was inherent that means for loading the optical disk were provided in order for the data on the disk to be read as disclosed by Yamauchi in Fig. 13 Step S206), for detachably accommodating an external storage medium (it was inherent that the disks were removable in order for them to function as a normal DVD as disclosed by Yamauchi Col. 11 Lines 34-38) for storing copyrighted data (See Yamauchi Col. 11 Lines 34-

38); a cross-authentication means for cross-authenticating said general-purpose computer with said external storage medium through said loading means (See Yamauchi Col. 13 Paragraphs 8-9 and Fig. 9 Element S105); and a control means for enabling the general purpose computer to store said copyrighted data from said internal storage means (See Yamauchi Figs. 14b and 14c) directly into said external storage medium without the use of intermediary external equipment such as a portable device (See Yamauchi Fig. 15 and Col. 26 Paragraph 2) upon successful cross-authentication by said cross-authentication means (See Yamauchi Fig. 14a), and a reproduction means for reproducing data read from said external storage medium (See Yamauchi Fig. 5 Element 46 and Fig. 13 Element S206), wherein in the cross-authentication means (See Yamauchi Fig. 5 Elements 46 and 47 "Authentication Section"), the control means (See Yamauchi Fig. 5 Elements 46 and 47 "CGMS Control Section"), and the reproduction means (See Yamauchi Fig. 6 Element 501) are each constituted by a dedicated circuit which operates independently of said central processing unit (See Fig. 5 Element 49C).

16. Claim 2 recites that said control means, when said general-purpose computer has been cross-authenticated with said external storage medium (See Yamauchi Fig. 14a), reads said copyrighted data from said external storage medium and supplies said copyrighted data to said reproduction means (See Yamauchi Fig. 14b and Col. 18 Paragraph 1).

17. Claim 6 recites that a function equivalent to said reproduction means is realized by executing, by said central processing unit, a program stored in said internal storage means (See Yamauchi Col. 2 Paragraph 4).

18. Claim 7 recites that the internal storage means is a hard disc drive (See Yamauchi Col. 42 paragraph 1).

19. Claim 8 recites that the copyrighted data are music data (See Yamauchi Col. 1 Technical Background wherein "audio information" falls within the scope of "music").

20. Claim 9 is rejected for the same reasons as claim 1 above.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

22. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi, and further in view of Doi (U.S. Patent Number 5,432,947).

Yamauchi disclosed that the data read is initiated by the data reproduction microcontroller (See Yamauchi Col. 18 Paragraph 6) and that the read data is put into a data buffer (See Yamauchi Col. 18 Paragraph 7). Yamauchi failed to disclose that the power was supplied to each circuit separate from the power supplied to the CPU and also failed to disclose that the CPU received no power during the reading of the data from the external storage medium. However, Yamauchi also did not mention that the CPU played any role during the reading of the external medium.

Doi teaches that supply voltages to any device can be individually controlled (See Doi Col. 18 Paragraph 9). Doi further shows that the voltage supplied to a device can be cut to 0V, shutting off the power to that device (See Doi Fig. 18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Doi to the invention of Yamauchi in order to shut off the power to the idle CPU while reading the data from the external medium. This would have been obvious because the ordinary person skilled in the art would have been motivated to reduce the power consumed by the system.

23. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamauchi and Doi as applied to claim 4 above. Claim 5 recites displaying an operation during the CPU inactive state. Yamauchi disclosed displaying an error message to the user during reading when copying of requested data is prohibited (See Yamauchi Col. 41 Paragraph 1).

Response to Arguments

24. Applicant's arguments filed 11/26/2004 have been fully considered but they are not persuasive.

25. With regard to claim 1 applicant traverses primarily that Yamauchi includes an intermediary external device. However, this is not the case as Yamauchi disclosed that the disk reproduction drive was connected to the internal bus and was therefore not an external intermediary device (See Yamauchi Col. 26 Paragraph 2). As such, the examiner does not find the applicant's arguments persuasive and has maintained the rejection presented above.

26. By the same reasoning, the examiner has maintained the rejection of claim 9.

27. Further, the rejection of claims 2 and 6-8 have been maintained for the reasons give in the above with regards to claim 1.

28. With regards to claims 4-5, the examiner has maintained the rejection presented above, again for the same reasons as discussed for claim 1 above.

Conclusion

29. Claims 1-2, and 4-9 have been rejected.

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Mochizuki (U.S. Patent Number 6,097,814) disclosed a method for controlling the reproduction of data on a storage medium involving disk and drive mutual authentication.

b. Yeo (U.S. Patent Number 6,452,885) disclosed a copy protection method involving writing test data to the optical disk and using this data as a means for authenticating the disk.

c. Tagawa et al. (U.S. Patent Number 6,615,192) disclosed a copying system for copying disks involving copy authorization verification.

d. Utsumi et al. (European Patent Application Publication EP0773490A1) disclosed a copy protection means involving three-way authentication between the source, destination, and owner of the data.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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